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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/509,021      | 07/25/2000  | PETER J. JUNGER      | 723-835             | 7648             |

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EXAMINER

KAZIMI, HANI M

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3624

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/509,021

Applicant(s)

JUNGER, PETER J.

Examiner

Hani Kazimi

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5.6.9.12.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This application has been reviewed. Original claims 1-47 are pending. The rejections cited are as stated below:

#### ***Information Disclosure Statement***

2. Information Disclosure Statements filed, August 14, and November 8, 2000, April 9, 2001, and January 22, 2002 have been considered and are attached hereto. However, the remaining IDS filed Papers No. 8, 10, 11, and 13-15 have not been considered because, they are not in the file wrapper. Examiner is making an attempt to locate the missing papers.

#### ***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The scanned copy of the declaration is not clear, it is difficult to read the priority numbers of the listed applications, as required under 37 CFR 1.52(a)(1)(iv).

#### ***Double Patenting***

4. 35 U.S.C. § 101 reads as follows:

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"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

5. The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in the public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time wise extension of the right to exclude granted by a patent. In re Sarett, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); In re White, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993).

6. Claims 1-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,018,719, claims 1-56 of U.S. Patent No. 6,085,172, claims 1-58 of U.S. Patent No. 5,978,774, claims 1-43 of U.S. Patent No. 6,269,344 B1, and claims 1-8 of U.S. Patent No. 6,463,421 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations of claims 1-47 of the instant application are either taught in the claims of the issued patents or they recite means or steps that are substantially the same and that would have been obvious to one of ordinary skill in the art.

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Thus, the claims in the instant application are not patentably distinct from the U.S. Patents and are in fact the generic to the issued species claims. The difference is merely one of scope, in the instant application, claims 1-47 essentially repeat most of the features listed in the Patents listed above. However; instant application deletes certain limitations e.g. "an electronic database system containing sales transaction information on the uniquely identified products and vendor return criteria for the products".

The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. Instant claims, the deletion of an element with a corresponding loss of function from the patented claims would have been an obvious expedient as above. Further:

Claims 1-47 essentially repeat all the features listed in the Patents listed above, further recites additional steps that do not appear in the claims of the Patents mentioned above.

In particular, comparing the present application with Patent No. 6,463,421 or others that have fewer claims.

However, these added features are old and well known in the art, it would been obvious to one of ordinary skill in the art at the time of the invention to include these steps and elements as will be discussed with respect to the art rejection below because, it greatly improves the efficiency of the system by tracking the products information which can be helpful to the retailer, and provides a system that is user friendly.

7. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on a non-statutory double patenting ground provided the conflicting patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1-47 are rejected under 35 U.S.C. § 102(a) based upon a public use or sale of the invention as discussed in Discount Store News "New Policy System can Par Suspect Returns, Cut Losses", Discount Store News, Lebhar-Friedman Inc., January 1, 1996, 2 pages, ("hereinafter", Discount Store News).

Discount Store News discloses, the main features of the present invention such as scanning a UPC code when a product is purchased (e.g.) a Nintendo machine, and at the same time, scanning a separate code that contains the serial number of that particular Nintendo machine. Both codes are then transmitted and stored in a database for later retrieval for the purpose of verifying the validity of the product's return against applicable return qualifications.

The remaining elements and components of the claimed subject matter would have to be implemented at the time the article was published in order for the system to perform the above mentioned features.

**Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687 or 7658.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 1114.



**HANI M. KAZIMI**  
**PRIMARY EXAMINER**  
Art Unit 3624

February 9, 2004

**Requirement for Information Under 37 C.F.R. 1.105**

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to identify products and services embodying the disclosed subject matter of registering product transactions and the method of verifying the product return. The prior art discloses that Applicants have been operating the system since at least January 1996. However, Applicant fails to disclose any information regarding the system that may be material to the patentability of the disclosed invention. The Examiner reminds Applicants that they must disclose documents and publications known to them that are relevant to the subject matter of this application. In particular, copies of the system that was implemented in January 1996.

In response to this requirement, please provide the citation and a copy of each publication which any of the Applicants authored or co-authored and which describe the disclosed subject matter of registering product transactions and the method of verifying the product return.

In response to this requirement, please provide the names of any products or services that have incorporated the claimed subject matter and the disclosed prior art of registering product transactions and the method of verifying the product return.

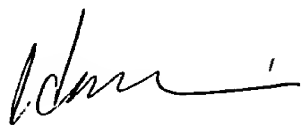


The fee and certification requirements of 37 C.F.R. 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. 1.105 are subject to the fee and certification requirements of 37 C.F.R. 1.97.

In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in Applicant's disclosure.

The Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the Applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete response to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is THREE months.



HANI M. KAZIMI  
PRIMARY EXAMINER